

**REMARKS**

Claims 77-86 and 109-148 were pending in the current application. Applicants have amended independent claims 77, 109, 119, 128, and 137 and added new dependent claims 149-163. No new matter has been added. Reexamination and reconsideration of all claims, as amended, is respectfully requested.

Applicants acknowledge and appreciate the indication of allowable subject matter for claims 83, 115, 124, 133, and 145 if rewritten to incorporate the limitations of the base claim and intervening claims.

**35 U.S.C. §§ 102/103**

The Office Action rejected independent claims 77, 79, 109, and 111, including independent claims 77 and 109, under 35 U.S.C. §102(b) based on Helfgott, U.S. Patent 4,323,243 (“Helfgott”). The Office Action also rejected claims 78, 85, 86, 110, 117, and 118 under 35 U.S.C. §103 based on Helfgott in view of certain alleged “general knowledge” in the art, and claims 80-82, 84, 112-114, 116, 119-123, 125-132, and 134-148, including independent claims 119, 128, and 137 under 35 U.S.C. 103 based on Helfgott in view of Wright et al., U.S. Patent 4,702,733 (“Wright”).

*§102*

The Helfgott design includes a piston 40 that drives a clamping member 52 that clamps collapsible conduit 7. With respect to timing control of the piston using the pneumatic control unit 14, Helfgott states that operation of the instrument (surgical instrument 5) is “positively coordinated” with fluid aspiration:

Positive coordination between the pneumatically powered surgical intrument [sic] and the aspiration and evacuation system is achieved by fluidly connecting both the instrument and the clamping means to the same power output, so that the aspiration and evacuation commences as

the reciprocating blade of the surgical instrument cuts and ceases as the blade withdraws.

Helfgott, Abstract.

Further, Helfgott spell out this “positive coordination” between fluid and blade operation at col. 5, l. 57 through col. 6, l. 2:

Generally speaking, pneumatic control unit 14 is a variable pneumatic oscillator capable of generating a variety of pneumatic waveforms. The period of these waveforms determines the period of the reciprocation of the blade within cutting tube 21 of surgical instrument 5. Like clamping assembly 10, the pneumatically operated surgical instrument 5 is also fluidly connected to the power output line 67 of the pneumatic control unit 14 by way of pneumatic connection means 65. The fact that both the instrument 5 and the clamping assembly 10 are both fluidly connected to the power output line 67 of the control means 14 via connection means 65 *insures a positive, direct coaction between the two*, as will become more apparent hereafter.

(Emphasis added)

See also, col. 7, ll. 27-30:

The fourth step of the process may include *simultaneously actuating the surgical instrument 5 and the clamping assembly 10* by fluidly connecting the pneumatic control unit 14 to a pneumatic power conduit 60.

(Emphasis added)

As shown by these passages, the blade of surgical instrument 5 positively and directly “co-acts” with the clamping assembly 10.

Applicants have amended all independent claims to now positively recite what had been recited in claims 119 and 128, namely ultrasonic energy delivery, and have amended all independent claims to require that “timing of the series of modulated differential pressure pulses is selectively alterable relative to timing of the modulated ultrasonic energy delivery.” (Claim 77, with similar limitations to all other independent claims) While no ultrasonic energy delivery occurs in Helfgott, Applicants note that Helfgott also fails to provide “selectively alterable” timing of fluid delivery relative to any other type of waveform – as noted, the timing of Helfgott fluid is “positively coordinated” with the Helfgott blade. As a result, Helfgott does not anticipate independent claims 77 and/or 109.

Claims depending from allowable claims 77 and 109 are also allowable as they include limitations not found in Helfgott. Applicants therefore submit that all claims are allowable for the foregoing reasons, and specifically that independent claims 77 and 109 are not anticipated by Helfgott.

Accordingly, all claims as amended are allowable under 35 U.S.C. §102.

### *§103*

With respect to independent claims 119, 127, and 138, in a manner similar to that discussed above, these independent claims have been amended to recite limitations such as “wherein timing of the modulated differential fluid pressure pulses is selectively alterable relative to timing of the modulated ultrasonic energy delivery” (claim 119, with similar limitation in claims 127 and 138). For the reasons presented above with respect to differences between Helfgott and limitations similar to those presented in the amended claims 119, 127, and 138, these independent claims are allowable over Helfgott in view of Wright. Applicants note that the “selectively alterable relative timing” limitations are missing from Wright, and thus the claims are allowable based on Helfgott in view of Wright. Claims depending from allowable claims 119, 127, and 138 are allowable as they include limitations not found in the cited references, alone or in combination.

Beyond the foregoing reasons demonstrating the allowability of all independent claims, Applicants discuss certain specific rejections made under 35 U.S.C. §103.

Claims 78, 85, 86, 110, 117, and 118 were rejected under §103 based on Helfgott. The rejection states that the times specifically recited in these claims are obvious, or are “only routine skill in the art.”

Applicants disagree and submit that the Office Action is relying on alleged “general knowledge” in the art to reject the present claims. In accordance with 37 C.F.R. § 1.104 (d)(2) and to preserve Applicants’ argument on appeal, Applicants request that the Examiner provide an affidavit that supports the rejection of the claims based on the official notice, common knowledge, or personal knowledge of the Examiner, or provide a reference demonstrating the purported common knowledge. *See In re Lee*, 277 F.3d 1338, 1344-45, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002) (finding that reliance on “common knowledge and common sense” did not fulfill the PTO’s obligation to cite references to support its conclusions, as PTO must document its reasoning’s on the record to allow accountability and effective appellate review).

The allegation that the recited times are mere “routine skill in the art” further demonstrates the requirement for such evidence. *In re Zurko*, 59 USPQ2d 1693 (Fed. Cir. 2001) (“This assessment of basic knowledge and common sense was not based on any evidence in the record and, therefore, lacks substantial evidence support. ... With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience -- or on its assessment of what would be basic knowledge or common sense”); Manual of Patent Examining Procedure 2144.03 (“If the applicant traverses [] an assertion [that a concept is ‘well known’ or ‘matters of common knowledge’] the examiner should cite a reference in support of his or her position.”). Should the Examiner continue to take issue with dependent claims 78, 85, 86, 110, 117, and 118, or any other claims on this basis, Applicants request that the Examiner produce a reference showing the timing claimed

(e.g. 100 milliseconds, 8 milliseconds, 25 milliseconds) or otherwise in accordance with the express terminology of the claim or claims, or an affidavit in support of the rejection.

Applicants also dispute the combination of Helfgott with general knowledge in the art, or “routine skill in the art,” as well as Helfgott with the Wright ultrasonic design in the manner suggested. Applicants submit that there is no reasoning supporting combining Helfgott with either general knowledge or the Wright reference, and that it is only through the use of impermissible hindsight that the Applicants’ claims may be constructed from the reference and purported knowledge in the art. Such hindsight reconstruction of the invention is impermissible. *In Re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991); *In Re Laskowski*, 871 F.2d 115, 117 (Fed. Cir. 1989); *see also, Ex Parte Lange*, 72 U.S.P.Q. 90, 91 (C.C.P.A. 1947).

The Patent Office must show that some reason to combine the elements with some rational underpinning that would lead an individual of ordinary skill in the art to combine the relevant teachings of the references. *KSR International Co. v. Teleflex Inc.*, No. 04-1350, 550 U.S. \_\_\_\_ (2007); *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988). Therefore, a combination of relevant teachings alone is insufficient grounds to establish obviousness, absent some reason for one of ordinary skill in the art to do so. *Fine* at 1075. In this case, the Examiner has not pointed to any cogent, supportable reason that would lead an artisan of ordinary skill in the art to come up with the claimed invention.

Reasoning supporting the combination includes “to achieve integration or emulsification of the target tissue...” Office Action, p. 5. This is merely a conclusion used to justify choosing references based on aspects presented in the claims. It is always beneficial to improve operation, cost, efficiency, and so forth, but the question is what reasoning would have been used by one of skill to take the ultrasonic teachings of the Wright device and modify them in a manner consistent with the Helfgott fluid design. Here, no such reason has been articulated. Conclusory reasoning such as that presented is improper hindsight reconstruction of the invention and for this further reason, claims 119,

128, and 137, as amended, and claims depending therefrom are allowable over the cited references.

Based upon the totality of the foregoing, Applicants respectfully submit that claims 77, 109, 119, 128, and 137, as amended, are allowable over the references of record, and all claims dependent therefrom are also allowable as they include limitations not present in the cited references .

Accordingly, it is respectfully submitted that all pending claims fully comply with 35 U.S.C. § 103.

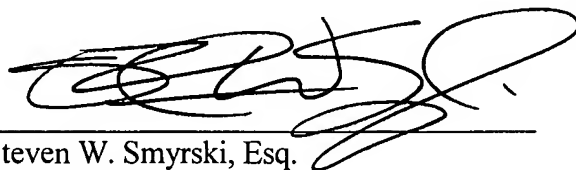
**CONCLUSION**

In view of the foregoing, it is respectfully submitted that all claims of the present application are in condition for allowance. Reexamination and reconsideration of all of the claims, as amended, are respectfully requested and allowance of all the claims at an early date is solicited.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Applicants believe that no fees are due in accordance with this Response. Should any fees be due, the Commissioner is hereby authorized to charge any deficiencies or credit any overpayment to Deposit Account 502026.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Smyrski', written over a horizontal line.

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